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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/906,713	08/05/97	LOK	S 97-52

HM11/0421

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EXAMINER	
KAUFMAN, C	
ART UNIT	**PAPER NUMBER**
1646	4

DATE MAILED: 04/21/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/906,713	Applicant(s) Lok et al.
	Examiner Claire M. Kaufman	Group Art Unit 1646

☒ Responsive to communication(s) filed on *Aug 5, 1997*.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *1* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-27* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *1-27* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-19, drawn to polynucleotide, vector, transformed cell, classified in class 435, subclass 69.1.

   II. Claims 20-23 and 27, drawn to polypeptide (ZCYTOR11), classified in class 530, subclass 350.

   III. Claim 24, drawn to method of detecting a ligand by binding to ZCYTOR11, classified in class 435, subclass 7.1.

   IV. Claim 25, drawn to antibody to ZCYTOR11, classified in class 530, subclass 388.22.

   V. Claim 26, drawn to anti-idiotype antibody, classified in class 530, subclass 387.2.

2. The inventions are distinct, each from the other because of the following reasons:

The polynucleotide of Invention I is related to the polypeptide of Invention II by virtue of encoding the same. The polynucleotide has utility for the recombinant production of the protein in a host cell, as recited in claim 19. Although the polynucleotide and polypeptide are related since the polynucleotide encodes the specifically claimed polypeptide, they are distinct inventions because they are structurally and functionally different products the polypeptide can be made by another and materially different process, such as by synthesis or purification from the natural source. Further, the polynucleotide may be used for processes other than the production of the protein, such as for nucleic acid hybridization for library screening or *in situ* localization.

Inventions I and III-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not capable of use together and have different

functions since the polynucleotide is structurally and functionally distinct from the antibodies and the polynucleotide cannot be used in the method of Invention III.

Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptide can be used in a materially different process such as in the production of antibodies.

The polypeptide of Invention II is related to the antibody of Invention IV by virtue of being the cognate antigen, necessary for the production of the antibodies. Although the polypeptide and antibody are related due to the necessary stearic complementarity of the two, they are distinct inventions because they are structurally and functionally different and the polypeptide can be used for another and materially different process other than for production of the antibody, such as in an assay to detect ligand binding or to purify the natural ligand of the polypeptide, or in assays for the identification of agonist or antagonists of the polypeptide.

Inventions II and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the polypeptide has no direct structural or functional relationship to the anti-idiotype antibody.

Invention III is unrelated to IV and V. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the antibodies of Inventions IV-V cannot be used in or made by the method of Invention III.

The antibody of Invention IV is related to the anti-idiotype antibody of Invention V by virtue of being the cognate antigen, to which the anti-idiotype antibody binds and useful for the production of the anti-idiotype antibody. Although the antibody and anti-idiotype antibody are related due to the necessary stearic complementarity of the two, they are distinct inventions because they are structurally and functionally different and the primary antibody can be used for another and materially different process other than for production of or binding by the anti-idiotype antibody, such as in a process for the immunoaffinity purification of the polypeptide for which the antibody is specific or for cellular localization of the polypeptide one the antibody is detectably labeled.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter, and the search required for each Invention is not coextensive with another, restriction for examination purposes as indicated is proper.

3. A telephone call was made to Paul Lunn on April 15, 1998 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Claire M. Kaufman, whose telephone number is (703) 305-5791. Dr. Kaufman can generally be reached Monday through Friday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Walsh, can be reached at (703) 308-2957.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. NOTE: If applicant *does* submit a paper by fax, the original signed copy should be retained by the applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office. **Please** advise the examiner at the telephone number above before facsimile transmission.

cmk
April 15, 1998

STEPHEN WALSH
SUPERVISORY PATENT EXAMINER
GROUP 1800